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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/751,943

01/07/2004

Lars Ivar Samuelson

A-9903

3601

22428 7590 02/12/2007

FOLEY AND LARDNER LLP

SUITE 500

3000 K STREET NW

WASHINGTON, DC 20007

EXAMINER

SUCH, MATTHEW W

ART UNIT

PAPER NUMBER

2891

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/751,943	SAMUELSON ET AL.	
	Examiner	Art Unit	
	Matthew W. Such	2891	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 and 67 is/are pending in the application.
- 4a) Of the above claim(s) 5-12 and 16-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 13-15 and 67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/20/06 & 6/30/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 13-15 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hantschel ('884) in view of Empedocles ('723).

Hantschel teaches a scanning probe microscope (SPM) cantilever tip which are terminated with a nanowhisker or carbon nanotube on the tip (Paragraph 0006; Figs. 1-4 and 7-8). A tip member is positioned at or adjacent the free end of a cantilever (Figs. 1-2). The cantilever is an elongated beam which is fabricated and therefore has predetermined shape and mechanical characteristics (Paragraphs 0002-0006). All materials and shape combinations are flexible, and the language of claims 3 and 14 do not limit the degree of flexibility in the cantilever.

Hantschel does not teach that the nanowhisker can be a doped large band-gap heterojunction.

Empedocles teaches a nanowhisker with a heterojunction (see for example, Para. 0010, 0016, 0030, 0044, 0066, 0067, 0086, 0179, 0201, etc.). The heterojunction can include a doped large band-gap material, such as a II-VI or III-V compound semiconductor (Para. 00149, 0175,

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etc.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a heterojunction in the nanowhisker in order to form functional elements from the nanowhisker, such as a transistor, or to provide selectively etchable portions (Para. 0002, 0030, 0086, etc.) thereby increasing the device functionality.

The functional language of “to provide in use a narrow energy distribution of electrons flowing therethrough” does not distinguish the claims from prior art. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

Hantschel also does not teach using a metal particle catalyst material in the nanowhisker.

Empedocles teaches growing nanowhiskers with a metal particle catalyst (Para. 0007, 0009, 0032, 0044, 0045, 0093, 0096, 0155, 0161). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a catalyst in the nanowhisker in order to pre-pattern and seed the growth of the nanowhisker (Empedocles Para. 0044, 0093, 0096).

Response to Arguments

3. Applicant's arguments with respect to claims 1-4, 13-15 and 67 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. Additional prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Gao ('861), Zhang ('681), Brown ('923) and Majumdar ('408) each teach various devices and configurations for nanowhiskers, including heterojunctions and catalysts.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew W. Such whose telephone number is (571) 272-8895. The examiner can normally be reached on Monday - Friday 9AM-5PM EST.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley W. Baumeister can be reached on (571) 272-1722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew W. Such
Examiner
Art Unit 2891

MWS
2/5/07



B. WILLIAM BAUMEISTER
SUPERVISORY PATENT EXAMINER
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